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In re Application of :
CIRPUS, et al. :
Serial No.: 10/590,457 :
PCT No.: PCT/EP05/01863 : DECISION ON PETITION
Int. Filing Date: 23 February 2005 :
Priority Date: 27 February 2004 : UNDER 37 CFR 1.181
Atty Docket No.: 13987-00020-US :
For: METHOD FOR PRODUCING POLY- :
UNSATURATED FATTY ACIDS IN TRANS- :
GENIC PLANTS :

This decision is in response to applicant's correspondence and filed 21 May 2007 in the United States Patent and Trademark Office (USPTO). The request is being treated under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 08 September 2006, applicant filed the present request for refund arguing that a preliminary amendment had been filed with the U.S. National stage entry eliminating all multiple dependencies.

DISCUSSION

On 23 February 2005, applicant filed international application PCT/EP05/01863, which claimed priority of an earlier application filed 27 February 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 September 2005. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 August 2006.

On 25 August 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an executed declaration and power of attorney; an English translation of the international application as filed; a preliminary amendment; a computer-readable form of the sequence listing and an Application Data Sheet.

On 14 March 2007, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an translation of the application into English and processing fee of \$130.00. In addition, applicant was advised of the need to provide a payment of \$1250.00 for 229 pages in

excess of 250 pages. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 02 April 2007, applicant was mailed an additional Form PCT/DO/EO/905 advising applicant of the need to provide payment of a processing fee of \$130.00 for providing an English translation of the international application later than 30 months from the priority date and to provide a payment of \$1250.00 for 229 pages in excess of 250 pages. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees. The form was accompanied by a withdrawal of the Form PCT/DO/EO/905 mailed 14 March 2007.

On 21 May 2007, applicant filed the present petition under 37 CFR 1.181 arguing that an English translation of the international application as filed was timely provided on 25 August 2006 and therefore payment of the \$130.00 surcharge was not necessary. In addition, applicant argued that applicant had filed a preliminary amendment on 25 August 2006 requesting the deletion of the paper copy of the Sequence Listing from the international application and replacement with Sequence Listing submitted on compact disc only.

DISCUSSION

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. (See MPEP 503). An examination of the petition finds that applicant has provided a copy of the date-stamped postcard receipt, as well as, a complete copy of the prior filing and a statement that the copy currently provided is a copy of the papers filed on 25 August 2006. The postcard identifies the application by serial number, title, applicant and attorney docket number. Among the items listed on the receipt is: "English language translation of the International Application" The receipt is stamped "IAP15 Rec'd PCT/PTO 25 AUG 2007." The postcard has not been annotated in any way to indicate that any of the listed items were not received. Thus, it is clear that applicant filed an English translation of the international application on 25 August 2006; within thirty months from the earliest claimed priority date. Thus, it is proper to grant applicant's petition to not have to pay the \$130.00 surcharge for untimely filing of an English translation of the international application.

Regarding the charging of \$1250.00 for 229 pages in excess of 250 pages, applicant is advised that the filing date of this application is the international filing date. The international application contained a paper copy of the sequence listing and was published with said paper version. Applicant is advised that an applicant is not allowed to amend the specification after the filing date. As such, applicant's preliminary amendment of 25 August 2006 to delete the paper copy of the Sequence Listing from the international application and replacement with Sequence Listing submitted on compact disc only is untimely. (See Manual of Patent Examining Procedure section 714.01(e)). In addition, it is noted that MPEP 1.825(a) provides that:

Any amendment to a paper copy of the "Sequence Listing" (§ 1.821(c)) must be made by the submission of substitute sheets and include a statement that the substitute sheets include no new matter. Any amendment to a compact disc copy of the "Sequence Listing" (§ 1.821(c)) must be made by the submission of a replacement compact disc (2 copies) in compliance with § 1.52(e). Amendments must also be accompanied by a statement that indicates support for the amendment in the application, as filed, and a statement that the replacement compact disc includes no new matter.

As such, there is no provision for amending a paper copy of a sequence listing filed in the international application with a computer readable version upon the entry of the National stage in the United States.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **DISMISSED** as to the need to provide payment of \$1250.00 for 229 pages in excess of 250 pages. The petition is **GRANTED** as to the timeliness of the filing of the English translation of the international application.

This application is being returned to the United States Designated/Elected Office (US/DO/EO) for the preparation and mailing of a "Notification of Defective Response" (Form PCT/DO/EO/916) indicating that applicant is required to provide payment of \$1250.00 for 229 pages in excess of 250 pages.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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